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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,192	01/15/2002	Heinrich Bachmann	20347 US1 (C38435/128985)	4078
7590 05/04/2004			EXAMINER	
Stephen M. Haracz, Esq. Bryan Cave, LLP 245 Park Avenue New York, NY 10167-0034			PAK, YONG D	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/053,192	BACHMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yong D Pak	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-27, 31-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 16-18 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s)          is/are allowed.
- 6) ☒ Claim(s) 6, 7, 10-15, 19-27, 31, 32 and 37 is/are rejected.
- 7) ☐ Claim(s)          is/are objected to.
- 8) ☐ Claim(s)          are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on          is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/504,393.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>        </u>                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>        </u>   | 6) <input type="checkbox"/> Other: <u>        </u>                          |

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### **DETAILED ACTION**

This application is a CIP of 09/504,393.

The amendment filed on February 9, 2004, amending claims 6, 11, 19 and 31, canceling claims 8, 9, 28-30 and 34-36, and adding claim 37, has been entered.

Claims 1-7, 10-27, 31-33 and 37 are pending.

### ***Election/Restrictions***

Claims 1-5, 16-18 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 12-15 are drawn to probes/primers comprising fragments and portions of SEQ ID NO:2. Therefore, these claims are drawn to a genus of DNA, with any structure. The genus of DNA that comprise these above fragments and portions of

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SEQ ID NO:2 is a large variable genus. Many structurally and functionally unrelated DNA are encompassed within the scope of these claims, including partial DNA sequences. The specification describes three probes/primers, SEQ ID NO:8, 9 and 10 do not provide adequate description. These partial sequences/fragments of SEQ ID NO:2 is claimed with open language and the genus encompasses a variety of species with widely varying attributes. The specification fails to describe any other representative species by any identifying characteristics or properties other than the "functionality" of being a probe/primer of SEQ ID NO:2 and fails to provide any structure: function correlation present in all members of the claimed genus.

Therefore, the specification is insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

### ***Response to Arguments***

The denial of priority under 35 U.S.C. 120 to its parent application, 09/504,393, has been withdrawn.

The objection have been withdrawn in light of the amendment filed on February 9, 2004.

The rejections under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph, has been withdrawn in light of the amendment filed on February 9, 2004.

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The rejections under 35 U.S.C. 102(b) and 102(a) have been withdrawn in light of the amendment filed on February 9, 2004.

The rejections under 35 U.S.C. 103(a) have been withdrawn in light of the amendment filed on February 9, 2004.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-7, 10-15, 19-27, 31-32 and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-15, 19-32 and 34-36 of copending Application No. 09/504,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to identical nucleic acid sequences encoding the same protein, identical primers/probes, identical kits comprising said primer/probe, identical methods of using said nucleic acid sequence and vectors and host cells comprising said nucleic acid sequence.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants have agreed that a terminal disclaimer will be submitted when the parent application is issued as a patent.

***Allowable Subject Matter***

No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong D. Pak  
Patent Examiner

April 27, 2004

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800